

## REMARKS

This is a full and timely response to the outstanding Office Action mailed April 9, 2003. Claims 17-36 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

The Office Action rejects claims 17-27 and 30-36 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,189,287 to *Parienti* ("Parienti"). The Office Action rejects claims 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Parienti in view of U.S. Patent No. 5,550,358 to Tait et al. ("Tait"). For at least the reasons set forth below, the Applicant respectfully requests reconsideration and withdrawal of these rejections and allowance of all pending claims.

### **I. Independent Claims 17, 26, 30, 32, 33, and 36 are Patentable over Parienti**

The Office Action rejects each of independent claims 17, 26, 30, 32, 33, and 36 under 35 U.S.C. §102(b) as allegedly unpatentable over Parienti. The Office Action alleges that "Parienti teaches a system for transmitting billing information (col. 3, lines 49+) comprising a portable remote access unit 1 which communicates with a terminal 11 via infrared (col. 3, lines 12+)."

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(*emphasis added*). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

***Independent Claim 17 and Dependent Claims 18-25***

Claim 17 recites:

17. A system for transmitting billing information to a communication device, comprising:  
receiving means operatively associated with the communication device for receiving data transmitted via electromagnetic waves; and  
a remote access unit having **a memory configured to store user identification data required to access the communication device** and a low-power **transmitter adapted to transmit the user identification data to the receiving means** when the remote access unit is within a close proximity to the receiving means, the remote access unit further comprising a **manually-operated transmit button** and a controller, responsive to the transmit button, to controllably retrieve user identification data from the memory and transmit the user identification data via the low-power transmitter.

*(Emphasis added.)* The Applicant respectfully submits that claim 17 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

In the present case, not every feature of the claimed invention is represented in Parienti. First, Parienti does not disclose **“a memory configured to store user identification data required to access the communication device.”** Parienti discloses several uses for terminal 11, which the Office Action equates with a “communication device.” Specifically, “terminal 11 will emit an infrared signal, recognized by the portable casing 1 as an invitation to transmit the elements concerning the flight chose and confirmed by the user during the acoustic transmission.” (col 3, lines 24-28). Further, “portable casing 1 will, in fact, dialogue with the terminal 11 in order to verify and validate the passage, if all is considered normal.” (col 3, lines 29-31). Additionally, “terminal 11 will enable the passenger to pass through, in accordance with any procedure adopted by the airline:

releasing a turnstile, emitting any type of acquiescence signal, etc.” (col. 3, lines 32-36). In summary, terminal 11 is used for negotiating passenger entry with a portable casing, the success of which is communicated via an acquiescence signal (e.g. opening a turnstile).

However, terminal 11 is not a “communication device” as stated in claim 17. The Applicant’s disclosure describes several embodiments of systems and methods for transmitting billing information. However, the particular embodiment captured in claim 17 specifically relates to using a **communication device**. A “communication device” may include devices such as “pay-type telephones” or “modems, ISDN converters, cable boxes, etc.” (pg. 7, lines 13-17). Additionally, “any type of communication device that must place a call or transmit information, and which must transmit billing information (such as an account number) may utilize the concepts of the present invention” (pg. 7, lines 17-19). Terminal 11, which is described in Parienti as a turnstile or other equipment used to acquire access to a particular physical area, does not meet this definition.

As noted in the Office Action, an alternate embodiment in Parienti is directed to a “means of payment.” However, again, this embodiment does not describe any interaction with a “communication device.” FIG. 6A also depicts a terminal similar to that highlighted in the Office Action. However, the detailed description does not supply any information as to the function of the terminal shown in FIG. 6A. Notably, other embodiments of the casing disclosed in Parienti communicate with devices using “acoustic” methods using a speaker and microphone. (*see* FIG. 4, FIG. 5, FIG. 6B, and FIG. 7). Certainly, communication via the “acoustic” methods shown and described in Parienti is not “electromagnetic” as also required by claim 17. Thus, the terminals depicted and described in Parienti are not the

claimed **"communication device"** such as "pay-type telephones" or "modems, ISDN converters, cable boxes, etc." or "any type of communication device that must place a call or transmit information, and which must transmit billing information (such as an account number) may utilize the concepts of the present invention" as described in the detailed description. (pg. 7, lines 13-19).

Even assuming, *arguendo*, that terminal 11 is a "communication device," Parienti does not teach, suggest, or disclose, and the Office Action does not even allege, that any **"user identification data"** in Parienti is **"required to access the communication device"** recited in claim 17. Instead, the Office Action merely alleges that the "portable unit contains [sic] memory area to **retain permanent data relating to the user**" (page 3, *emphasis added*).

Particular examples of the "user information" described in the Applicant's detailed description are, for example, a "banking and/or credit card", "checking account," "calling card number and any other appropriate data," or "calling card/billing info" (pg. 18, lines 14-21 – pg. 19, lines 1-14). Furthermore, this information is transmitted to the receiver inside the communication device, verified, and used for billing purposes. In contrast, the user information cited in the Office Action refers to subscription data residing on a memory chip used to activate the portable casing. (col. 2, line 18-20). Specifically, "[o]nce the removable chip 3 is snapped on, the apparatus will be able to communicate all kinds of data, at the request of the user, relating, for example, to the flights of an airline that could interest the subscriber." (col. 2, lines 31-34). Thus, apparently, it is not the user information such as

a credit card or other billing number, but rather "subscription" information contained within the memory that is used to verify whether the user can access terminal 11.

The "subscription" information of Parienti is not the same as "user information." Rather, the subscription information is merely an activated memory card with a renewed extension date, mailed to the subscriber on a periodic basis (col. 2, lines 29-34). In contrast, the embodiment of claim 17 describes using "user information" (e.g. billing identification) to instruct the communication device a particular user interaction (e.g. a call) is to be billed to a particular account. Furthermore, as another example, the "system may transmit the user identification information to a central office and await verification from the central office ..." (pg. 5, lines 11-12). Thus, Parienti does not teach, suggest, or disclose **"a memory configured to store user identification data required to access the communication device"** as expressly limited by claim 17.

Thus, it also follows that Parienti also does not teach, suggest, or disclose a **"transmitter adapted to transmit the user identification data to the receiving means"** as recited in claim 17. The portable casing in Parienti does not transmit user identification data required to *access* terminal 11, but rather sends requests for flight booking. (col. 2, lines 40-47). Rather than sending user identification information required to access the communication device, Parienti uses logic within the portable casing itself to evaluate subscription information on the "removable chip 3" to determine whether the user can access terminal 11 (col. 2, lines 29-34 and col. 5, lines 43-45). Thus, Parienti does not teach, suggest, or disclose a **"transmitter adapted to transmit the user identification data to the receiving means."**

The embodiments in Parienti using the "means for payment" appear to send "user identification data." However, this user identification data is not **"required to access the communication device."** Thus, while Parienti appears to teach transmitting account information between two portable systems or between a portable and a computer system (sometimes via an intermediate system), that account information is not sent to "access the communication device" as recited in claim 17.

Finally, claim 17 recites the limitation of **"a manually operated transmit button."** The Office Action admits that "Parienti does not explicitly suggest of [sic] a transmit button." However, the Office Action alleges "the unit 1 is capable of transmitting and receiving the data from the host or exchange data with other portable units (col. 4, lines 1-3)." Further, the Office Action alleges "[i]n triggering such transmittal and/or receipt of data, the device *should have a key* (may be a hard key or soft key) to initiate data transmission." (Office Action, pg. 3, *emphasis added*).

First, the Examiner is reminded that "[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(*emphasis added*). Thus, for a proper rejection under 35 U.S.C. §102, the burden is on the Patent Office to show that **each and every** claimed feature of the claimed invention is represented in the applied reference to constitute a proper rejection. Here, the Office Action goes so far as to admit that the feature of a **manually operated transmit button** is not shown. For this reason alone, the rejection under 35 U.S.C. §102 is improper.

Second, the Applicant disagrees with the allegation that the “device should have a key ... to initiate data transmission.” For example, the detailed description of Parienti states that “when the user has to pass through different gates or an access passage 20 in order to embark on the plane, a permanent specialized terminal 11 will emit an infrared signal, recognized by the portable casing 1 as an invitation to transmit the elements concerning the flight chosen and confirmed by the user during the acoustic transmission described previously.” (col. 3, lines 21-28). Thus, in the example given in the detailed description, the portable casing does not use a “**manually operated transmit button**,” but rather merely responds to an invitation to transmit from terminal 11.

Furthermore, based on the Parienti disclosure, it simply is not possible to ascertain whether the reference contains a manually operated transmit button. For example, it is certainly conceivable, that each portable casing is programmed to continually ping a compatible device without the intervention of a “manually operated transmit button.” Thus, at a minimum, the rejection is improper for the reason that the required limitation of a “**manually operated transmit button**” is not explicitly taught by Parienti. But even more, the detailed description specifically recites that “terminal 11,” rather than the portable casing, initiates the communication by “emit[ting] and infrared signal, recognized by the portable casing.” Thus, the recited limitation of a “**manually operated transmit button**” is not taught, suggested, or disclosed by Parienti.

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 17 patently defines over Parienti, and therefore should be allowed. Furthermore, because independent claim 17 patently defines over Parienti, dependent claims 18-

25 are allowable as a matter of law for at least the reason that claims 18-25 contain all the features and elements of their corresponding independent claim. See, e.g. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

***Independent Claim 26 and Dependent Claims 27-29***

Claim 26 recites:

26. A method for transmitting information to a communication device, comprising the steps of:  
retrieving predefined user identification information from an internal memory of a remote access unit, **wherein the user identification information is required to access the communication device;**  
formatting the retrieved user identification information into a predefined signal for transmission to the communication device when the remote access unit is within a close proximity to the communication device; and  
transmitting **a low-power electromagnetic signal, comprising the formatted user identification information, to the communication device.**

(*Emphasis added.*) The Applicant respectfully submits that claim 26 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

Claim 26 is directed to a system for providing remote access to a communication device. However, the system of claim 26 employs similar limitations as in claim 17. In that the Office Action rejects claim 26 on substantially the same basis as claim 17, and the distinctions of claim 17 have been thoroughly covered, the Applicant merely highlights the substantial differences between claim 26 and Parienti.

First, terminal 11 is not a “**communication device**” as defined by the detailed description and embodied within claim 26. Second, in contrast to the “subscription” information stored in the memory chip of Parienti, claim 26 recites that the internal memory contains user identification



information, **"wherein the user identification information is required to access the communication device."** Third, Parienti does not teach, suggest, or disclose **"a low-power electromagnetic signal, comprising the formatted user identification information, to the communication device"** as recited in claim 26. Rather, Parienti discloses merely sending information such as requests for flight bookings.

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 26 patently defines over Parienti, and therefore should be allowed. Furthermore, because independent claim 26 patently defines over Parienti, dependent claims 27-29 are allowable as a matter of law for at least the reason that they contain all features and elements of their corresponding independent claim. See, e.g. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

#### ***Independent Claim 30 and Dependent Claim 31***

Claim 30 recites:

30. A system for providing remote access to a communication device, comprising:  
a receiver associated with the **communication device** and configured to receive data transmitted via electromagnetic waves;  
a remote access unit having **a memory configured to store user identification data required to access the communication device** and a low-power transmitter **adapted to transmit the user identification data to the receiver** when the remote access unit is within a close proximity to the receiver, the remote access unit further comprising **a manually-operated transmit button** and a controller, responsive to the transmit button, to controllably retrieve user identification data from the memory and transmit the user identification data via the low-power transmitter.

(*Emphasis added.*) The Applicant respectfully submits that claim 30 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

Claim 30 is directed to a system for providing remote access to a communication device. However, the system of claim 30 employs similar limitations as in claim 17. In that the Office Action rejects claim 30 on substantially the same basis as claim 17, and the distinctions of claim 17 have been thoroughly covered, the Applicant merely highlights the substantial differences between claim 30 and Parienti. First, terminal 11 is not a **“communication device”** as recited in claim 30. Second, in contrast to the “subscription information” stored in the memory chip of Parienti, claim 30 recites **“a memory configured to store user identification data required to access the communication device.”**

Third, Parienti does not teach, suggest, or disclose **“a low-power transmitter adapted to transmit the user identification data to the receiver”** as recited in claim 30. Rather, Parienti discloses merely sending information such as requests for flight bookings. Finally, Parienti simply does not disclose **“a manually-operated transmit button.”**

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 30 patently defines over Parienti, and therefore should be allowed. Furthermore, because independent claim 30 patently defines over Parienti, dependent claim 31 is allowable as a matter of law for at least the reason that it contains all the features and elements of its corresponding independent claim. See, e.g. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

*Independent Claim 32*

Claim 32 recites:

32. A computer readable storage medium containing program code for controlling the operation of a system for transmitting billing information to a **communication device**, comprising:  
receiving means for receiving data transmitted via electromagnetic waves;  
and  
a remote access unit having **a memory configured to store user identification data required to access the communication device** and a low-power transmitter **adapted to transmit the user identification data to the receiving means** when the remote access unit is within a close proximity to the receiving means, the remote access unit further comprising a **manually-operated transmit button** and a controller, responsive to the transmit button, to controllably retrieve user identification data from the memory and transmit the user identification data via the low-power transmitter.

*(Emphasis added.)* The Applicant respectfully submits that claim 32 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

Claim 32 is directed to a computer readable storage medium containing program code for controlling the operation of a system for transmitting billing information to a communication device. However, the computer readable storage medium of claim 32 employs similar limitations as in claim 17. In that the Office Action rejects claim 32 on substantially the same basis as claim 17, and the distinctions of claim 17 have been thoroughly covered, the Applicant merely highlights the substantial differences between claim 32 and Parienti.

First, terminal 11 is not a "**communication device**" as defined by the detailed description and embodied within claim 32. Second, in contrast to the "subscription" information stored in the memory chip of Parienti, claim 32 requires "**a memory configured to store user identification**

**data required to access the communication device.”** Third, Parienti does not teach, suggest, or disclose “a low-power transmitter **adapted to transmit the user identification data to the receiver**” as required by the express limitations of claim 32. Rather, Parienti discloses merely sending information such as requests for flight bookings. Finally, Parienti simply does not disclose “**a manually-operated transmit button.**”

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 32 patently defines over Parienti, and therefore should be allowed.

***Independent Claim 33 and Dependent Claims 34-35***

Claim 33 recites:

33. A computer readable storage medium containing program code for **transmitting user identification information to a communication device**, wherein **the user identification information is required to access the communication device**, the program code comprising the steps of:  
depressing a **manually-operative transmit button** of a remote access unit;  
retrieving predefined user identification information from an internal memory of the remote access unit;  
formatting the retrieved user identification information into a predefined signal for transmission; and  
**transmitting a low-power electromagnetic signal, including the formatted user identification information**, when the remote access unit is within a close proximity to the communication device.

*(Emphasis added.)* The Applicant respectfully submits that claim 33 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

Claim 33 is directed to a computer readable storage medium containing program code. However, the computer readable storage medium of claim 33 employs similar limitations as in claim 17. In that the Office Action rejects claim 33 on substantially the same basis as claim 17, and

the distinctions of claim 17 have been thoroughly covered, the Applicant merely highlights the substantial differences between claim 33 and Parienti.

First, terminal 11 is not a **“communication device”** as recited in claim 33. Second, in contrast to the “subscription” information stored in the memory chip of Parienti, claim 33 recites that **“user identification information is required to access the communication device.”** Third, Parienti does not teach, suggest, or disclose **“transmitting a low-power electromagnetic signal, including the formatted user identification information”** as recited in claim 33. Rather, Parienti merely discloses sending information such as requests for flight bookings. Finally, Parienti simply does not disclose **“a manually-operated transmit button.”**

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 33 patently defines over Parienti, and therefore should be allowed. Furthermore, because independent claim 33 patently defines over Parienti, dependent claim 34 is allowable as a matter of law for at least the reason that claim 34 contains all features and elements of its corresponding independent claim. See, e.g. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

***Independent Claim 36***

Claim 36 recites:

36. A system for providing remote access to a communication device, comprising:

**a financial institution, wherein the communication device is disposed for communication with the financial institution via a telecommunication link;**  
a remote access device having **a single user-depressible button, a memory configured to store user identification data required to access the communication device,** a low-power transmitter, and **a controller configured to control the transmitter to transmit track one and track two data in direct response to a manual depression of the user-depressible button, without any verification of user identification data,** the controller being configured to control the transmitter to transmit a plurality of synchronization bits preceding the user identification data; and

a receiver disposed within the communication device, the receiver configured to receive information transmitted via electromagnetic waves, wherein **the receiver is specifically configured to receive user identification data** transmitted from the remote access unit by recognizing and synchronizing to the synchronization bits.

*(Emphasis added.)* The Applicant respectfully submits that claim 36 patently defines over Parienti for at least the reason that Parienti fails to disclose, teach, or suggest the features emphasized in bold text above.

Claim 36 is directed to system for providing remote access to a communication device. However, the system of claim 36 employs similar limitations as in claim 17. In that the Office Action rejects claim 36 on substantially the same basis as claim 17, and the distinctions of claim 17 have been thoroughly covered, the Applicant merely highlights the substantial differences between claim 36 and Parienti. **In addition, the Applicant submits that the rejection is improper for failing to even allege certain limitations of claim 36.**

First, terminal 11 is not a **"communication device"** as recited in claim 36. Second, in contrast to the subscription information stored in the memory chip of Parienti, claim 36 recites **"a memory configured to store user identification data required to access the communication device."**

In addition to the features above, the rejection fails to even allege that Parienti discloses the limitation of **"a financial institution, wherein the communication device is disposed for communication with the financial institution via a telecommunication link"** as recited in claim 36. Furthermore, even assuming *arguendo* that the terminals 1 and 11 shown in FIG. 6A or FIG. 8, are "communication devices," Parienti discloses that terminals 1 and 11 communicate with a "computer center 18" or an "access passage 20" (col. 3, lines 23 and col. 4, line 51). Neither the computer center 18, or the access passage 20, are described in the detailed description as a "financial institution."

Finally, the rejection fails to even allege that Parienti discloses **"a controller configured to control the transmitter to transmit track one and track two data in direct response to a manual depression of the user-depressible button, without any verification of user identification data"** as recited in claim 36. First, as explained in distinguishing claim 17, Parienti does not disclose a "user-depressible button" that operates to "transmit" data. Further, "track one and track two data" is not even mentioned in Parienti. Further, as explained extensively above in relation to claim 17, Parienti verifies the ability to access a remote device by using "subscription information" within a memory card inside the controller. However, claim 36 requires that a transmitter transmit track one and track two data **"without any verification of user identification data."** Thus, Parienti verifies the ability to access a terminal within the portable casing, before

sending any data. In contrast, the embodiment of claim 36 requires that the data be sent "without any verification."

Accordingly, and for at least these reasons, the Applicant respectfully submits that independent claim 36 patently defines over Parienti, and therefore should be allowed.

## **II. Claims 28 and 29 are Patentable Over Parienti in View of Tait**

The Office Action rejects claims 28 and 29 under 35 U.S.C. §103(a) as being allegedly unpatentable over Parienti in view of Tait. In that claims 28 and 29 depend directly from independent claim 26, which Applicant submits to be patentable, dependent claims 28 and 29 are allowable as a matter of law for at least the reason that claims 28 and 29 contain all features and elements of their corresponding independent claim. See, e.g. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).



### CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 17-36 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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